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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,846	11/25/2003	Craig M. Carter	42P17488	8171
59796 7590 02/21/2008 INTEL CORPORATION c/o INTELLEVEATE, LLC P.O. BOX 52050 MINNEAPOLIS, MN 55402				
EXAMINER				
LONG, PONYA M				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/722,846

Applicant(s)

CARTER ET AL.

Examiner

FONYA LONG

Art Unit

4127

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This communication is a First Action Non-Final on the merits. Claims 1-32, as originally filed, are currently pending and have been considered below.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per Claims 1 and 17, the claim recites the limitation "the financial value" in Line 4 for Claim 1 and Line 5 for Claim 17. There is insufficient antecedent basis for this limitation in the claim.

As per Claims 10 and 26, the claim recites the limitation "the person" in Lines 7 and 9. There is insufficient antecedent basis for this limitation in the claim.

As per Claims 10 and 26, the claim recites the limitation "the catalogue" in Lines 13 and 14. There is insufficient antecedent basis for this limitation in the claim.

Claims 1-9, 11-16, 18-25, and 27-32 depend from Claims 1 and 17 and therefore contain the same deficiencies.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 9, 17, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Formale et al. (US 2004/0215544).

As per Claims 1 and 17, Formale et al. discloses a web-based tool for managing used assets (Abstract, discloses a business asset management system) comprising: enabling submission of a surplus item into an active items list, wherein the surplus item is no longer being used by a direct user ([0025-0027] discloses an asset owner being allowed to update inventory information for assets identified as surplus and effectively dispose of or transfer the surplus asset); assessing the financial value and condition of the surplus item ([0024] discloses the current values of all of the fixed assets of the organization and data relating to the financial allocation of the asset values to the various departments within the organization; and [0036] discloses identifying the condition of the asset); and enabling a company to determine a disposition path for the surplus item based on the assessment of the surplus item ([0028-0029] discloses the asset owner determining the disposition path of the asset (i.e., scrap, loss, donation, sale, or trade)).

As per Claims 9 and 25, Formale et al. discloses updating one or more databases based on results for the disposition path chosen for the surplus item ([0025] discloses updating the system comprising a personnel, an inventory, and a financial database to reflect the current status of the asset).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-4, 6, 18-20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Formale et al. (US 2004/0215544) in view of Examiner's Official Notice.

As per Claims 2 and 18, Formale et al. discloses the disposition path for the surplus item comprising scrapping the surplus item ([0028-0029] discloses the asset owner choosing to scrap the surplus asset item). However, Formale et al. fails to explicitly disclose the item being scrapped with there is no value left in the surplus item.

The examiner takes Official Notice that it is old and well known in the art to scrap an item when there is no value left.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the asset management system of Formale et al.

to scrap an item when the item is of no value in order to aide in reducing the amount of assets that are needed to be managed.

As per Claims 3 and 19, Formale et al. discloses the disposition path for the surplus item comprising donating the surplus item ([0028-0029] discloses the asset owner choosing to donate the surplus asset item). However, Formale et al. fails to explicitly disclose the item being donated when the item has value but is no longer beneficial to the company.

The examiner takes Official Notice that it is old and well known in the art to donate items that have value but no longer is beneficial to the owner (company).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the asset management system of Formale et al. to donate an item when the item is of value but is no longer beneficial to the company in order to provide a tax benefit to the company.

As per Claims 4 and 20, Formale et al. discloses the disposition path for the surplus item comprising reselling the surplus item ([0028-0029] discloses the asset owner choosing to sale the surplus item to an employee or to a third party). However, Formale et al. fails to explicitly disclose reselling the surplus item when the value of the surplus item outweighs the benefit of the item to the company.

The examiner takes Official Notice that it is old and well known in the art to resell an item that has value that outweighs the benefit to the owner (company).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the asset management system of Formale et al.

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to resell an item that has value that outweighs the benefit to the company in order to make profit for the company.

As per Claims 6 and 22, Formale et al. discloses the disposition path for the surplus item comprising enabling reuse of the surplus item (Abstract, discloses reusing surplus items by allowing employees to be able to transfer assets to other employees). However, Formale et al. fails to explicitly disclose reusing the surplus item when the item provides value for the company.

The examiner takes Official Notice that it is old and well known in the art to reuse (i.e., retain) an item when the item is of value to the company.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the asset management system of Formale et al. to reuse an item that has value to the company in order to save money for the company.

7. Claims 5 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Formale et al. (US 2004/0215544) in view of Kelly et al. (5,424,944).

Formale et al. discloses the claimed invention as applied to Claim 1, above. However, Formale et al. fails to explicitly disclose refurbishing the surplus item.

Kelly et al. discloses a method for controlling the disposition of an asset with the concept of refurbishing the surplus item for reuse of the surplus item within the company (Abstract, discloses a method of asset disposition wherein an asset owner may decide to refurbish the asset).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the asset management system of Formale et al.

to include refurbishing the surplus item as taught by Kelly et al. in order to eliminate the cost of purchasing a new item.

8. Claims 7 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Formale et al. (US 2004/0215544) in view of Wang (US 2004/0117287).

Formale et al. discloses the claimed invention as applied to Claim 1, above. However, Formale et al. fails to explicitly disclose reviewing production information, depreciation information, and asset information.

Wang et al. discloses a method for valuing fixed assets with the concept of reviewing production information ([0009] discloses reviewing product information such as asset name and asset type), depreciation information ([0021] discloses reviewing depreciation information), and asset information ([0018] discloses reviewing asset information such as asset purchase prices).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the asset management system of Formale et al. to include reviewing product information, depreciation information, and asset information as taught by Wang et al. in order to determine the cost savings for the disposition of each asset.

9. Claims 8 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Formale et al. (US 2004/0215544) in view of DeWolf et al. (US 2002/0032626).

Formale et al. discloses the claimed invention as applied to Claim 1, above. However, Formale et al. fails to explicitly disclose determining a reseller; adding the surplus item to a lot for the reseller, and shipping the surplus item to the reseller.

DeWolf et al. discloses a global asset information registry with the concept of reselling the surplus item comprising: determining a reseller ([0073] discloses deciding to sell the asset to a buyer who may be a reseller after obtaining ownership rights); adding the surplus item to a lot for the reseller ([0080] discloses a lot of asset items being provided to a distributor (i.e. reseller)); and shipping the surplus item to the reseller ([0080] discloses shipping the lot of asset items to a distributor (i.e., reseller)).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the asset management system of Formale et al. to include determining a reseller, adding the surplus item to a lot for the reseller, and shipping the surplus item to the reseller in order to acquire money by reselling the surplus item.

10. Claims 10-12, 16, 26-28, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Formale et al. (US 2004/0215544) in view of Saunders et al. (US 2003/0233277).

As per Claims 10 and 26, Formale et al. discloses enabling the surplus item to be reused within the company (Abstract, discloses reusing the surplus item by allowing employees to be able to transfer assets to other employees), wherein enabling the surplus item to be reused comprises: placing the surplus item in an on-line public catalogue to allow an employee to purchase surplus items from the catalogue, wherein the surplus item will remain in the catalogue within a second predetermined time period ([0035-0037] discloses surplus items being placed on a list that is available to

employees via on-line for purchase for thirty days). However, Formale et al. fails to explicitly disclose items being waitlisted and reserving a surplus item.

Saunders et al. discloses an automated system that tracks the fulfillment of rainchecks with the concept of comparing a description of the surplus item with items that have been waitlisted ([0003] discloses comparing inventory with a items placed on a raincheck by receiving inventory and matching it with a raincheck form and taping the raincheck form to the item); if a match is found, placing the surplus item on reserve in an on-line personal catalogue ([0003] discloses reserving an item via storing the marked product for the customer); notifying the person who waitlisted the item that the surplus item has been put on reserve ([0003] discloses notifying the customer that the rainchecked item is available); and enabling the person to order the item within a first predetermined time period ([0003] discloses the customer having a designated period of time to retrieve the product if the customer does not return for the product, the item is placed on the store shelves).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the asset management system of Formale et al. to include items being waitlisted and reserving a surplus item in order to effectively allocate assets to persons in need.

As per Claims 11 and 27, Formale et al. discloses wherein if the surplus item remains in the catalogue within the second predetermined time period without being ordered by an employee, the method further comprises removing the surplus item from the on-line public catalogue for re-evaluation (Claim 10, discloses placing the identified

assets on a list of surplus assets for a predetermined period of time. [0036-0037] discloses once the predetermined period has passed, an asset owner can then decide to dispose of the asset such as by scrapping it).

As per Claims 12 and 28, Formale et al. discloses the claimed invention as applied to Claim 10 and 26, above. However, Formale et al. fails to explicitly disclose removing the surplus item from reserve if the person does not order the surplus item.

Saunders et al. discloses an automated system that tracks the fulfillment of rainchecks with the concept of enabling the person to order the item within a first predetermined time period comprising removing the surplus item from reserve if the person does not order the surplus item ([0003] discloses the customer having a designated period of time to retrieve the product, if the customer does not return for the product, the item is placed on the store shelves for the public).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the asset management system of Formale et al. to include removing the surplus item from reserve if the person does not order the surplus item in order to reallocate the surplus item to a person desiring the surplus item.

As per Claims 16 and 32, Formale et al. discloses enabling one or more employees to browse an on-line public catalogue to search for wanted surplus items ([0037] discloses allowing employees to look at available assets via the online asset management system). However, Formale et al. fails to explicitly disclose waitlisting a surplus item.

Saunders et al. discloses an automated system that tracks the fulfillment of rainchecks with the concept of when a surplus item is not found, waitlisting the surplus item, wherein the employee who waitlisted the surplus item is given priority over the waitlisted item ([0003] discloses when runs out of stock for a product, a person receives a raincheck for that item. When the item is re-stocked the person having the raincheck for the item is given priority for be item by the store storing the item for the customers for a designated period of time).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the asset management system of Formale et al. to include waitlisting a surplus item as taught by Saunders et al. in order to effectively allocate assets to persons in need.

11. Claims 13 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Formale et al. (US 2004/0215544) in view of Wiecha (5,870,717) and in further view of Gilberto et al. (US 2003/0158791).

Formale et al. discloses enabling one or more employees to browse an on-line public catalogue to search for wanted surplus items ([0036-0037] discloses allowing employees to look at available assets via the online asset management system); and updating one or more databases with information regarding the surplus item upon receipt of the response ([0025] discloses automatically updating the financial records which are stored on the financial database to reflect the status change of the asset). However, Formale et al. fails to explicitly disclose ordering the surplus item; obtaining approval of the ordered surplus item; and shipping the surplus item.

Wiecha discloses a system for ordering item over a computer network with the concept of ordering a surplus item (Abstract, discloses an employee submitting an order for an item); awaiting approval of the ordered surplus item (Col. 1, Lines 25-30, discloses awaiting approval of the purchase order); if the ordered surplus item is approved, enabling the surplus item to be shipped to the employee (Col. 1, Lines 39-40, discloses submitting the purchase order to the supplier on behalf of the employee).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the asset management system of Formale et al. to include ordering the surplus item and obtained approval of the ordered surplus item as taught by Wiecha in order to save money by reusing assets within the company.

Gilberto et al. discloses a method for facilitating shipment in a networked environment with the concept of notifying the employee that the surplus item has been shipped ([0037] discloses shipping information being visible to the customer wherein [0043] shipping information includes showing the status of shipment as "shipped"); and awaiting a response from the employee that the surplus item has been received ([0010] discloses a seller receiving shipment confirmation that a customer has received their order).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Formale et al. and Wiecha combination to include shipping the surplus item as taught by Gilberto et al. in order to provide the employee with the asset.

12. Claims 14, 15, 30, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Formale et al. (US 2004/0215544) in view of Wiecha (5,870,717) and Gilberto et al. (US 2003/0158791), and in further view of Officer (US 2003/0233243).

As per Claims 14 and 30, the Formale et al., Wiecha, and Gilberto et al. combination discloses the claimed invention as applied to Claims 13 and 29, above. However, the combination fails to explicitly disclose providing incentive credits to employees.

Officer discloses a method for cross site capital asset sharing with the concept of providing incentive credits to employees for submitting surplus items that are reused within the company ([0028] discloses providing an incentive to employees for participation to capital asset sharing initiative program).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Formale et al., Wiecha, and Gilberto et al. combination to include providing incentive credits to employees as taught by Officer in order to recognize the employees efforts in providing cost savings resulting from the sharing of assets.

As per Claims 15 and 31, the Formale et al., Wiecha, and Gilberto et al. combination discloses the claimed invention as applied to Claims 14 and 29, above. However, the combination fails to explicitly disclose sending appreciation emails.

Officer discloses a method for cross site capital asset sharing with the concept of sending appreciation emails to employees for submitting surplus items that are reused

within the company ([0012] discloses sending an email to express appreciation for savings attributable to at least one of the groups involved in sharing the asset).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Formale et al., Wiecha, and Gilberto et al. combination to include sending appreciation emails as taught by Officer in order to show gratitude to the employees for their efforts in providing cost savings resulting from the sharing of assets.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Leeds et al. (US 2002/0188537) discloses a method and a system to increase an entity's return on assets by allowing the entity to redeploy idle and surplus assets.

Costello et al. (US 2002/0116281) discloses a fully integrated asset management system for used industrial equipment and machinery.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FONYA LONG whose telephone number is (571)270-5096. The examiner can normally be reached on Mon-Thur 7:30am-6:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynda Jasmin can be reached on (571) 270-3033. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FML

/Lynda Jasmin/

Supervisory Patent Examiner, Art Unit 4127